

## REMARKS/ARGUMENTS

The Office Action of February 9, 2005, has been carefully reviewed and this response addresses the Examiner's concerns stated in the Office Action. All objections and rejections are respectfully traversed.

Claims 7-10 and 17-20 are rejected as failing to comply with the enablement requirement.

Claims 1, 3-5, 11, and 13-15 are rejected as being anticipated by Marullo et al., U.S. Patent Number 6,044,398, issued on March 28, 2000 (Marullo). Applicants have amended claim 1 to correct a typographical error. No new matter has been added.

Claims 2, 6-10, 12, and 16-20 are rejected as being unpatentable over Marullo in view of Ramanathan et al., U.S. Patent 6,041,041 (Ramanathan), issued on March 21, 2000 (Ramanathan).

The Title of the invention, and Paragraph 35 of the Specification have been amended to respond to Examiner's remarks and to correct an invalid reference, respectively. FIG. 11 has been deleted in response to the objection in the Office Action.

Applicants have amended claim 16 to correct a reference inconsistency. No new matter has been added.

### *Objections*

On page 2, paragraph 1, of the Office Action, Examiner states that the title is not descriptive and that a new title is required that is clearly indicative of the invention to which the claims are directed. Applicants have herein amended the title of the invention.

On page 2, paragraph 2, of the Office Action, the amendment filed June 19, 2001 is objected to because the Office Action states that the amendment introduces new matter into the disclosure because Figure 11 was not of the original disclosure. Applicants have deleted Figure 11.

On page 2, paragraph 3, of the Office Action, claim 16 is objected to because of the following informality: it is suggested that claim 16 depend upon independent claim 10.

Applicants respectfully point out that claim 10 is a dependent claim. Applicants have amended claim 16 to depend upon independent claim 11.

***Rejections - 35 USC § 112, first paragraph***

On pages 2-3, paragraphs 4-5, of the Office Action, claims 7-10 and 17-20 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. The Office Action states that the claims contain subject matter that was not described in the specification in such a way as to enable one skilled in the art to make and/or use the invention.

The Office Action states that claims 7 and 17 disclose elapsed time but not in connection to what times are elapsed. Applicants respectfully point out that, on page 11, lines 11-21, of the Specification, Applicants describe that test instructions 121 can direct processor 111 to record browser activity as a series of steps. Test instructions 121 can also direct processor 111 to edit the transaction to specify test measurements for each step of browser activity.

As an example, one step of browser activity could be the request for a web page. A next step could be entering information into the web page. These steps could be recorded by the system of the present invention as an operator is visiting the web site. For each step, the system of the present invention can maintain test measurements that are related to the steps of the transaction. One possible test measurement that can be recorded as a web site is visited and later reset to account for varying network conditions, for example, is elapsed time associated with the step of visiting the web site, for example

Applicants respectfully assert that it is clear from the description that elapsed time as a test measurement associated with steps of browser activity is the elapsed time between when the step begins and when it ends. Applicants further assert that claims 7 and 17 are fully enabled by the specification.

The Office Action states that claims 8, 9, 18, and 19 disclose a required string or a prohibited string in a server response but not what type strings or the functions of the strings or an example of the strings. The Office Action states that the specification does not disclose how the strings relate as a test measurement.

Test measurements as disclosed in the Specification on page 11, lines 11-21, have been discussed previously and that discussion will not be repeated here. In the case of required and prohibited strings, it is well-known that standard web browser activity typically requires certain data entry in the form of ASCII strings. Likewise, web browser activity can prohibit certain strings, for example, strings with certain prohibited characters. The type and function of the strings depend on the web page that is being visited.

Applicants assert that it is clear from Applicants' specification that required and prohibited strings are possible test measurements that can vary depending on the web page being visited and can take on many possible values, thus providing an example of a string value is not necessary. Applicants further assert that claims 8, 9, 18, and 19 are fully enabled by the Specification.

The Office Action states that claims 10 and 20 disclose recording pauses and redefining pauses. The Office Action states that the specification discloses "pauses for the URL" but does not disclose what the pause is related to (i.e. collecting links to the URL, displaying URL, obtaining URL web page?). The Office Action states that the specification is silent on how to redefine a pause.

Applicants respectfully refer to Applicants' Specification, page 11, lines 21-22. The Specification states that test instructions 141 may direct processor 111 to record pauses for the steps and edit the transaction to redefine the pauses. For example, if a first step is to visit a web page and a second step is to enter data into the web page, the system of the present invention would record the pause between the first and second steps, the pause perhaps being used to properly perform the test associated with the transaction. Because conditions on a network can change, the system of the present invention allows the value of the pause to be redefined.

In addition, in FIGs. 6 and 7, the Specification discloses screens that display values for "pause". In particular, FIG. 7 discloses an "edit transaction" toolbar in which values for pause appear.

Applicants assert that it is clear that pauses are a real part of web browsing and that systems that perform tests that include web site visiting might have to take pauses into account. Applicants further assert that claims 10 and 20 are fully enabled by the specification.

***Rejections - 35 USC § 102***

On pages 3-5, paragraphs 6-11, of the Office Action, claims 1, 3-5, 11, and 13-15 are rejected under 35 U.S.C. § 102(e) as being unpatentable over Marullo. Please note that claim 1 is the base claim for claims 3-5 and claim 11 is the base claim for claims 13-15.

In all of the rejections, Marullo is the primary or sole reference, and Ramanathan is the secondary reference. Applicants respectfully point out that Marullo does not disclose interacting with a conventional web browser to record web browser activity. In fact, Marullo teaches away from interacting with a conventional web browser.

Marullo discloses a test subsystem that traverses and saves links and then uses those links to test web server applications and scripts by simulating a web browser. Marullo describes the process of the invention to include the steps of extracting links from web pages, traversing the web pages pointed to by the links in order to build a set of web pages to be used for testing, building a definition file with test cases, creating web pages to run the necessary tests on the web application, and exercising the web server by simulating multiple users (col. 7, lines 10-56).

Applicants respectfully point out that Marullo teaches a test system that does not depend upon a conventional or commercial web browser such as the NETSCAPE NAVIGATOR® or INTERNET EXPLORER®, and by avoiding such dependency on conventional web browsers, the capturing of data from the web server application may be accomplished without manual navigation (col. 14, line 60 -- col. 15, line 2).

In the present invention, test instructions direct a processor to interact with a web browser and an Internet server system to record web browser activity. Applicants' system relies on the existence of a conventional (referred to also as "actual" and "commercial" in Marullo's specification) web browser in order to construct transactions that test an Internet Server system.

With respect to claims 1 and 11, on pages 4 and 5 of the Office Action, in paragraphs 7 and 11,

(a) The Office Action states that Marullo discloses a software product for a computer system to configure a transaction for a user operating a web browser wherein the transaction is used for automated testing of an Internet server system, the software product comprising: test instructions configured direct a processor to interact with the web browser and the Internet server system to record web browser activity to generate the transaction (i.e. webrunner, Marullo, col. 7, line 10 – col. 8, line 17).

Applicants respectfully point out that Marullo teaches away from the use of a conventional web browser by disclosing that a facility to provide fast, non-stop posts and gets from the server could not be effected by employing conventional browsers with up to 50 or more manual user/testers (col. 7, lines 50-56). Applicants respectfully point out that Marullo's webrunner exercises and verifies web server applications by simulating an actual (conventional, commercial) web browser using TCP/IP sockets (col. 8, line 2). Marullo further states that the simulated web browser may be thought of as a virtual dynamic web browser for performing automated web server application verification and testing (col. 7, lines 66-67). Applicants, on the contrary, rely on a standard web browser to configure a test transaction (see Applicants' Specification , page 12, paragraph 25).

(b) The Office Action states that Marullo discloses that the test instructions are configured to direct a processor to interact with the web browser and the Internet server system to record web browser activity to generate a transaction and edit the transaction (Marullo, col. 8, lines 4-17; col. 16, lines 54 – col. 17, line 13; and col. 23, lines 5-24).

Applicants respectfully point out that Marullo discloses a system that may receive input from either an input file or a user/tester employing GUI edit field input. Marullo's system creates web pages to run tests on a web application, but does not generate a transaction from recorded web browser activity. Applicants assert that, with no transaction generated in such a way, Marullo does not disclose editing the transaction.

Marullo also discloses virtual browsers that get and post data at a rapid rate (col. 23, lines 5-24), but the data are not saved, and thus not examined, compared, nor edited. Applicants respectfully point out that users, in the system of Marullo, can edit an input file, but the input file is not a file of recorded web browser activity, as claimed by Applicants.

(c) The Office Action states that Marullo discloses that the test instructions are configured to direct a processor to interact with the web browser and the Internet server system to record web browser activity to generate a transaction and to perform an automated test of the Internet server system using the transaction (Marullo, col. 8, lines 18-26 and col. 24, lines 10-27).

Applicants respectfully point out that Marullo discloses automatically looping the test system through input data for as many iterations as specified in the input data (col. 8, lines 18-26). In teaching contrary to Applicants', Marullo discloses that a stress system can be run without user intervention to reflect real-life conditions, a situation which, Marullo teaches, could not be duplicated with conventional browsers without the undesirable use of a large number of testers (col. 24, lines 10-27).

Applicants further respectfully point out that nowhere does Marullo disclose interaction with an actual (standard or commercial) web browser to form a transaction to be used to perform an automated test.

(d) The Office Action states that Marullo discloses that the test instructions are configured to direct a processor to interact with a web browser and an Internet server system to record web browser activity to generate a transaction, perform an automated test using the transaction, and display test results to the user from the automated test (Marullo, col. 14, lines 55-65 and col. 21, lines 34-67).

Applicants respectfully point out that Marullo discloses a test system that provides a virtual browser for testing of web servers and associated applications without the dependency upon an actual (standard or commercial) web browser such as the NETSCAPE NAVIGATOR® or INTERNET EXPLORER® (col. 14, line 64). In Applicants' system, the display of test results is from an automated test, the automated test is performed using a transaction, and the transaction is generated by recording web browser activity. There is no web browser in the system of Marullo, and therefore user interface and other screens of Marullo cannot be the same in look or content with Applicants' display of test results.

(e) The Office Action states that Marullo discloses that the test instructions are configured to direct a processor to interact with a web browser and the Internet server system to record web browser activity to generate a transaction, perform an automated test of the Internet server system using the transaction, and save the transaction for subsequent automated testing of the Internet server system; and a storage medium configured to store the test instructions (Marullo, col. 8, lines 4-40).

Applicants respectfully point out that Marullo discloses a test system that can store requested and returned data and log information into files. Contrary to the claims of Applicants, Marullo does not disclose saving a transaction that is generated from recorded web browser activity because Marullo does not disclose a web browser. Marullo does not disclose a storage medium that stores test instructions that direct a processor to interact with a web browser because Marullo does not disclose a web browser.

Applicants respectfully point out that Marullo does not anticipate each and every element of Applicants' claim 1, nor does Marullo anticipate each and every step of Applicants' claim 11. Therefore, claims 1 and 11 (as well as dependent claims 2-10 and 12-20) are not anticipated by Marullo and a rejection under 35 U.S.C. § 102(e) is inappropriate. Applicants respectfully request the withdrawal of the rejection under 35 U.S.C. § 102(e) directed to claims 1 and 11, and therefore dependent claims 2-10 and 12-20, and find claims 1 and 11, and therefore dependent claims 2-10 and 12-20, in condition for allowance.

To further Applicants' position of the patentability of claims 3-5 and 13-15, Applicants note the following.

With respect to dependent claims 3 and 13, which depend from independent claims 1 and 11 respectively, the Office Action states that Marullo further discloses that the test instructions are further configured to direct the processor to record the web browser activity to generate test measurements (Marullo, col. 6, lines 24-49).

Applicants respectfully point out that Marullo teaches away from the use of a standard web browser in that Marullo discloses that prior art solutions of employing conventional browsers are unacceptable due to the compatibility and performance issues

they introduce. Marullo discloses an automated test system that requests, captures, stores, and verifies data returned from web servers. The web server application tool can accept links from a GUI edit field or a data file, save the returned pages (returned from accessing the links) from the application, verify the returned pages, and tally the results of the verification.

The system of Marullo does not interact with a web browser (standard or commercial) but instead follows links that have been previously provided, gathers data from those links, stores the data, and verifies it. Applicants record web browser activity to generate test measurements.

With respect to dependent claims 4 and 14, which depend, through dependent claims 3 and 13, from independent claims 1 and 11, the Office Action states that Marullo further discloses one of the test measurements is a sequence of web pages (Marullo, col. 3, lines 1-35 and col. 7, lines 10-35).

Applicants respectfully point out that Marullo discloses that a list of links in a data file is traversed and the web pages from the traversal are returned and stored for later use. Contrary to the claims of Applicants, Marullo states that it is highly desirable to avoid use of a conventional browser per se, so as to avoid the browser's interfering with the tests which are of real interest (col. 3, lines 1-35).

With respect to dependent claims 5 and 15, which depend from independent claims 1 and 11 respectively, the Office Action states that Marullo further discloses the test instructions are further configured to direct the processor to add test measurements to the transaction including transaction time and transaction data transfer rate (Marullo, col. 4, line 66 – col. 5, line 7).

Applicants respectfully point out that Marullo discloses that time of transaction, total number of bytes transferred, and transfer time are stored in a log file for comparison to data obtained from other tests. In Applicants' system, on the contrary, transaction time and transaction data rate are test measurements that result from transaction tests where the transaction is generated by recording web browser activity. Marullo's time of transaction is the time at which a financial transaction occurred. Applicants' transaction time is the

time required for a transaction generated by the recording of web browser activity, to complete. Marullo's total number of bytes transferred is the amount of data exchanged during the financial transaction. Marullo's transfer time is the amount of time required to exchange the total number of bytes transferred. Applicants' transaction data rate is the rate at which data were transferred during the transaction generated by recording web browser activity.

***Claim Rejections - 35 USC § 103***

On pages 5-7, paragraphs 12-19, of the Office Action, Examiner has rejected claims 2, 6-10, and 16-20 under 35 U.S.C. § 103(a) as being unpatentable over Marullo in view of Ramanathan et al., U.S. Patent 6,041,041 (Ramanathan).

Because Marullo has many deficiencies as presented above, and those deficiencies are not taught or disclosed by Ramanathan and are not even addressed by the Examiner, Applicants assert that the rejection of claims 2, 6-10, and 16-20 under 35 USC 103 is inappropriate.

To even further support Applicants' position with respect to the patentability of claims 2, 6-10, and 16-20, Applicants note the following.

On pages 6 and 7 of the Office Action, paragraphs 15 and 19, with respect to claims 2 and 12, the Office Action states that Marullo substantially discloses the claimed subject matter. Further, the Office Action correctly states that Marullo does not specifically disclose that test instructions are further configured to direct the processor to interact with the web browser and the Internet server system through a firewall. The Office Action states that Ramanathan discloses test instructions through a firewall (col. 6, line 34 – col. 7, line 20).

Because of the shortcomings of Marullo, Applicants respectfully point out that the teachings of Ramanathan and Marullo together do not describe test instructions that direct a processor to interact with a web browser and an Internet server system to record web browser activity through a firewall. Both Marullo and Ramanathan teach away from the use of a web browser to generate a transaction. The shortcomings of Marullo have been

discussed and will not be repeated here. Ramanathan teaches emulation of structures necessary for testing:

Like a subscriber terminal, a test target is also assigned a network address and responds to test packets directed to it. Since the test targets are installed in the ISS 60 solely to assist in measuring and monitoring of services in the ISS 60, they are guaranteed to be available for testing at all times (unlike subscriber terminals). Moreover, since the performance of the test targets is known a priori, the test targets serve as reliable end points for testing against to evaluate the performance of different networking modules of the ISS 60. (col. 6, lines 59-67)

On pages 6 and 7 of the Office Action, paragraphs 16 and 19, with respect to claims 6 and 16, the Office Action states that Marullo-Ramanathan further discloses the test instructions are further configured to direct the processor to record the browser activity as a series of steps and to edit the transaction to specify test measurements for each step. (Marullo col. 6, line 24-49; col. 16, line 54-col. 17, line 13; and col. 23, lines 5-24) (Ramanathan, col. 10, line 22 – col. 11, line 54).

Marullo and Ramanthan teach away from a system that records web browser activity as a series of steps. Marullo states that prior art solutions of employing conventional browsers were unacceptable. Marullo teaches virtual browsers that get and post data to the server at a rapid rate. Both Marullo and Ramanthan teach emulating a web browser because of test performance considerations.

Further, Marullo teaches a web server application tool that accepts links from a GUI edit field or data file, whereas Applicants claim test instructions that direct a processor to record browser activity (automatically records links). The editing of Applicants is for the purpose of specifying test measurements. Marullo, on the contrary, teaches an automated system that discards data which is not critical to the testing, and saves and reuses returned data (from web server interaction) for subsequent transaction use and testing, automatically providing web pages with all the data required to run the tests.

Applicants could not locate, in the Ramanathan reference, teachings related to recording browser activity as a series of steps, nor editing a transaction to specify test measurements for each step.

On page 7 of the Office Action, paragraphs 17 and 19, with respect to claims 7-9 and 17-19, the Office Action states that Marullo-Ramanathan further discloses one of the test measurements for each step is elapsed time, one of the test measurements for each step is a required string in an Internet server system response, and one of the test measurements for each step is a prohibited string in an Internet server system response. (Marullo col. 8, line 27-40; col. 16, lines 54-65; and col. 30, line 58 – col. 31, line 9) (Ramanathan, col. 2, line 26 – col. 3, line 11, and col. 10, line 22 – col. 11, line 54).

The meanings given by Applicants' specification of elapsed time, required string, and prohibited string have been provided previously and will not be repeated here. The transfer time of Marullo refers to a data transfer rate, not elapsed time between steps in a transaction as Applicants' claim.

Applicants respectfully request a citation that makes obvious required and prohibited strings in an Internet server system response as Applicants could find no reference to these elements in Marullo or Ramanathan.

On page 7 of the Office Action, paragraphs 18 and 19, with respect to claims 10 and 20, the Office Action states that Marullo-Ramanathan further discloses the test instructions are further configured to direct the processor to record pauses for the steps and edit the transaction to redefine the pauses. (Marullo col. 23, line 14 - col. 24, line 24) (Ramanathan, col. 16, lines 51-64).

The meaning given by Applicants' specification of recording pauses and editing a transaction to redefine the pauses has been provided previously and will not be repeated here. Marullo teaches the use of a system that does not employ a conventional browser (col. 24, lines 20-24). Marullo teaches looping through a series of tests for which test data have been automatically gathered, and for which users can specify port and server to test, and can specify sleep values between loops. Marullo teaches neither steps in a web browser-based transaction nor pauses between those steps. Ramanathan does not make up this deficiency. Ramanathan teaches computing a rating for a module that was tested. Ramanathan teaches that the rating is to be computed periodically, once every rating period, according to a timer.

Further, with respect to utilization of Ramanathan as a reference, Applicants assert that this reference falls into the "common ownership" exception created by 35 U.S.C. 103(c). Applicants present support for this position and the proof common ownership below.

**Statement of common ownership**

Ramanathan was filed on April 15, 1997, and issued on March 21, 2000, and, Applicants assert, falls into the 35 U.S.C. 103(c) exception for jointly owned inventions. Applicants assert that the present invention and the Ramanathan reference were owned by, or subject to an obligation of assignment to, the same company, Agilent Technologies Inc. (Agilent), at the time the invention that is the subject of the present invention was made. Therefore, under 35 U.S.C. 103(c), Ramanathan shall not preclude patentability of the present invention. 35 U.S.C. 103(c) states:

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Section 706.02(l) of the MPEP further states:

It is important to recognize that 35 U.S.C. 103(c) applies only to consideration of prior art for purposes of obviousness under 35 U.S.C. 103. It does not apply to or affect subject matter which is applied in a rejection under 35 U.S.C. 102. A patent applicant urging that subject matter is disqualified has the burden of establishing that it was commonly owned at the time the claimed invention was made. Absent proper evidence of common ownership at the time the later invention was made, the appropriate rejection under 35 U.S.C. 102(f) or 35 U.S.C. 102(g) as it applies through 35 U.S.C. 103 should be made. See MPEP § 706.02(l)(2) for information pertaining to establishing common ownership.

The SEC filing that created Agilent as a spin-off from the Hewlett-Packard Corporation (HP) took place on August 16, 1999, with an "Effective Date" of August 12, 1999.

The SEC filing contains a Master Patent Ownership and License Agreement (attached hereto), effective as of the "Effective Date" of the SEC filing. In this document, the following definitions apply:

**1.2 AGILENT PATENTS.** "Agilent Patents" means:

- (a) the Assigned Patents; . . . and
- (b) every Non-Design Patent to the extent entitled to a First Effective Filing Date prior to the expiration of the Capture Period, provided that, at any time after the First Effective Filing Date of any such Non-Design Patent and prior to the expiration of the Capture Period, Agilent (or any Subsidiary or Affiliated Company of Agilent):
  - (i) has ownership or control of any such Non-Design Patent, or
  - (ii) otherwise has the right under such Non-Design Patent to grant any licenses of the type and on the terms herein granted by Agilent without the obligation to pay royalties or other consideration to Third Parties; and
- (c) applications for the foregoing Non-Design Patents described in Section 1.2(b), including without limitation any continuations, continuations-in-part, divisions and substitutions; but

**1.4 ALLOCATED PATENT ASSETS DATABASE.** "Allocated Patent Assets Database" means the Allocated Patent Assets Database, as it may be updated by the parties upon mutual agreement to add Patents, Patent applications and Invention Disclosures as of the Separation Date.

**1.5 ASSIGNED PATENTS.** "Assigned Patents" means only those

- (a) Patents, Patent applications and Invention Disclosures allocated to Agilent in the Allocated Patent Assets Database;
- (b) Patent applications filed on the foregoing Invention Disclosures described in Section 1.5(a);
- (c) continuations, continuations-in-part, divisions and substitutions of any of the foregoing Patent applications described in Sections 1.5(a) and (b);
- (d) Patents which may issue on any of the foregoing Patent applications described in Sections 1.5(a)-(c);
- (e) renewals, reissues, reexaminations and extensions of the foregoing Patents described in Sections 1.5(a) and (d); and
- (f) foreign Patent applications and Patents that are counterparts of any of the foregoing Patent applications or Patents described in Sections 1.5(a)-(e), including any Patent application or Patent to the extent that it claims priority from any of the foregoing Patent applications or Patents described in Sections 1.5(a)-(e); but
- (g) excluding from any Patent or Patent application described in Sections 1.5(c)-(f) any claim (i) directed to subject matter that does not appear in any Patent application having a First Effective Filing Date prior to the Separation Date and (ii) of which neither Agilent nor any person having a legal duty to assign his/her interest therein to Agilent is entitled to be named

as an inventor.

**1.6 CAPTURE PERIOD.** "Capture Period" means the period ending five (5) years from the Separation Date.

**1.18 SEPARATION DATE.** "Separation Date" means 12:01 a.m., Pacific Time, November 1, 1999 or such other date as may be fixed by the Board of Directors of HP.

The Ramanathan reference meets the criteria for transfer from HP to Agilent, and underwent assignments as follows:

Reel/Frame	Assignor	Assignee	Recordation Date
<u>008762/0578</u>	Srinivas Ramanathan Edward H. Perry Tai Jin	Hewlett-Packard Co.	10/27/1997
<u>010841/0649</u>	Hewlett-Packard Co., a California Corp.	Hewlett-Packard Co., a Delaware Corp.	4/28/2000
<u>011089/0573</u>	Hewlett-Packard Co.	Agilent Technologies Inc.	8/22/2000

With respect to the status of the present invention under 35 U.S.C. 103(c), the MPEP § 706.02(l)(2) states that an invention is made when conception is complete as defined in *Mergenthaler v. Scudder*, 11 App D.C. 264, 81 O.G. 1417, 1897 C.D. 724 (D.C. Cir. 1897); *In re Tansel*, 253 F.2d 241, 117 USPQ 188 (CCPA 1958). See *Pfaff v. Wells Elecs.*, 525 U.S. 55, 119 S.Ct. 304, 312, 48 USPQ2d 1641, 1647 (1998) ("the invention must be ready for patenting . . . by proof that prior to the critical date the inventor had prepared drawings or other descriptions of the invention that were sufficiently specific to enable a person skilled in the art to practice the invention"). See 1241 O.G. 96 (12/26/2000).

On April 26, 2000, a design document that was sufficiently specific to enable a person skilled in the art to practice the invention as set forth in the present invention was completed. Therefore,

since the effective date of the Intellectual Property transfer that took place on August 12, 1999 in conjunction with the formation of Agilent, and

the making of the present invention, as set forth in the present invention, was completed on or about April 26, 2000,

then the subject matter sought to be patented and the prior art (Ramanathan) were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same company.

***Conclusion***

The rejection of claims 7-10 and 17-20 for failing to comply with the enablement requirement under 35 USC 112 has been overcome.

In view of the absence from any cited reference of Applicants' claimed invention as set forth above, Applicants respectfully urge that Marullo and Ramanathan, separately or in combination, are not sufficient to render the presently claimed invention anticipated under 35 U.S.C. 102(e) or obvious 35 U.S.C. § 103(a).

Applicants further assert that claims 2, 6-10 and 16-20 also stand allowed because Ramanathan is an inappropriate reference under the 35 USC 103(c) exception.

Therefore, since independent claims 1 and 11 are believed to be in condition for allowance and all dependent claims are believed to depend upon allowable independent claims, this application is in condition for immediate allowance.

The Commissioner for Patents is authorized to charge additional fees or credit overpayment to Deposit Account No. 50-1078.

The following information is presented in the event that a call may be deemed desirable by the Examiner:

JACOB N. ERLICH (617) 854-4000

Respectfully submitted,  
Ellen M. Nelson et al., Applicants

Date: May 9, 2005

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